

REMARKS

This Amendment is filed in response to the Office Action dated March 22, 2007.

Rejection Under 35 U.S.C. §103

Claims 1-2, 7-10, 13-16, 21 and 24-25 are rejected under 35 U.S.C. §103 as being anticipated by Mankins et al. (U.S. Patent No. 6,850,209) in view of Pettus (Des. 380,011). Claim 1 (apparatus claim) and Claim 21 (associated method claim) have been amended to recite: “**within a retail establishment at a point-of-sale or a point-of-purchase** in an elevated position that wherein the polygonal display is located within a retail outlet in an elevated position;...”. This is an aspect that is not found in Mankins et al. since the three dimensional display recited in Mankins et al. is specifically located outside. Applicant’s Published Patent Application recites: “These lines or queues can be found at retail establishments.” (Paragraph [0003], Line 1-2). “In another aspect of this present invention, a three-dimensional advertising display is disclosed. The advertising display includes a frame, a first side, a second side and a third side that cooperatively form an advertising display, further including a support mechanism, e.g., pipe or pole, attached to the frame to support the advertising display near **a point-of-sale or a point-of-purchase**.” (Paragraph [0009], Lines 1-7). Therefore, no new matter has been added.

There is a stationary display disclosed in Column 28, Lines 46-56 of Mankins et al. This passage recites: “FIG. 22 illustrates components of one embodiment, 346A, of a non-mobile unit 346 of the type illustrated in FIG. 18. This embodiment of a non-mobile unit includes a single display screen 344. In other embodiments, the non-mobile unit can have two or more displays, such as, for example, **a display on each of two opposite facing sides**.” There does not seem to

PATENT

be any recitation of a triangular version of the non-mobile unit. Since the triangular version is described extensively throughout the patent application regarding the movable vehicle application, it is clear that this is a teaching away from a triangular version of a non-mobile unit.

The Supreme Court held in *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. This is specifically mandated by the Manual of Patent Examining Procedure (M.P.E.P.) §2141.02 that recites: “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) §2143.03 that “to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Moreover, Pettus shows a center mount that is located underneath the advertising display. Claim 1 (apparatus claim) and Claim 21 (associated method claim) have been amended to recite: “the center pole solely via the single mount **located within the advertising display;**” This is clearly shown in FIG. 12 so that no new matter has been added. The security and stability of a mount located within the advertising display provides significant advantages over Pettus. A

**PATENT**

statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000).

Therefore, Claims 1-2, 7-10, 13-16, 21 and 24-25 are patentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Pettus (Des. 380,011).

Claims 17-18, 20 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) and Pettus (Des. 380,011) in view of Goldman (U.S. Patent No. 4,679,341). Claims 17-18, 20 and 26 all depend from Claim 1 and have all of the limitations thereof. **Claims 17-18, 20 and 26 are patentable over Mankins et al. and Pettus in the same manner as Claim 1 above since if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.** *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, a specific requirement of Goldman is that: “The present invention comprises a modular display apparatus for slidably receiving, maintaining and displaying one or more flat multi-sided signage panels in a **desired orientation**.” (Column 1, Lines 63-66). This is a marked contrast to the Applicant’s invention that specifically requires: “...wherein the at least one first display panel, the at least one second display panel and the at least one third display panel are facing **generally in different directions**;...”. Therefore, the prior art teaches away by stipulating that there must be a single **desired orientation** rather than

different directions. The Supreme Court held in *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. This is specifically mandated by the Manual of Patent Examining Procedure (M.P.E.P.) §2141.02, which recites: “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) §2143.03 that “to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). In this case, the limitation regarding the three displays panels facing three different directions is not found in Goldman, which requires the rectangular display panel face in a single, desired direction. When evaluating a claim for obviousness, all claim limitations must be considered. *In re Evanega*, 829 F.2d 1110, 4 U.S.P.Q. 2d 1249 (Fed. Cir. 1987).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit

**PATENT**

showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to modify or combine references); *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Moreover, “if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). In this case a reference, i.e., Goldman, requires the advertising display face a single “desired direction.” This will create a tremendous problem and destroy the recited purpose of the advertising display if it is simultaneously facing and viewed from three different directions. “In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972).

Therefore, Claims 17-18, 20 and 26 are respectfully believed to overcome the rejection under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. and Pettus in view of Goldman.

**PATENT**

Claim 19 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Pettus (Des. 380,011) in view of Goldman (U.S. Patent No. 4,679,341) and further in view of Gebka (U.S. Patent No. 5,458,307). Claim 19 depends from Claim 18 and overcomes the rejection under 35 U.S.C. §103(a) in the same manner as Claim 18 recited above. Moreover, Claim 19 depends from independent Claim 1. **If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.** *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, Gebka recites: “Since plastic price channels are generally made as extrusions of somewhat **hard polyvinyl chloride (PVC)** having a low friction or glossy outer surface, a problem which may arise in use, is that inserted labels can slide and become easily displaced along the channel to positions in which they may no longer be properly positioned relative to the products with which they are intended to be associated. The present invention **overcomes this problem**, at least to a substantial extent.” (Column 1, Lines 19-27). Therefore, although rigid PVC material is disclosed, Gebka teaches away from a hard PVC by the use of: “It is an object of the invention to provide an improved plastic price channel of the kind referred to which reduces the ability for attached labels to slide along the channel. . . . The rib coating may be co-extruded from a **“flexible” PVC** such as Teknor Apex Company’s 3165 Compound or Synergistics’ Clear Compound 0750. Of course, these commercially available PVC extrusion compounds are identified as illustrative.” (Column 1, Lines 32-57). Therefore, the invention in Gebka is to use a flexible PVC in a plastic price label to reduce friction when moved along the channel. Someone with ordinary skill in the art would be taught away from utilizing rigid PVC upon review of this reference for both the exterior shell and backing member. The Supreme Court held in *U.S. v.*

**PATENT**

*Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966), that one important indicium of nonobviousness is “teaching away” from the claimed invention by the prior art or by experts in the art at (and/or after) the time the invention was made. This is specifically mandated by the Manual of Patent Examining Procedure (M.P.E.P.) §2141.02 that recites: “A prior art reference must be considered in its entirety, i.e., as a **whole**, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).”

Therefore, Claim 19 is respectfully believed to overcome the rejection under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. in view of Goldman and further in view of Gebka.

Claim 28 was rejected under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. (U.S. Patent No. 6,850,209) in view of Pettus (Des. 380,011) and further in view of Boland (U.S. Patent No. 1,537,523). Claim 28 is now amended to depend from Claim 1 and overcomes the rejection under 35 U.S.C. §103(a) in the same manner as Claim 1 recited above. **If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious.** In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Moreover, Boland also shows a pole mounted underneath a display in FIG. 1. It is well established in U.S. Patent Law as well as the Manual for Patent Examining Procedure (M.P.E.P.) Section 2143.03 that “to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art”. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165

**PATENT**

U.S.P.Q. 494, 496 (C.C.P.A. 1970). Consequently, it is respectfully believed to be axiomatic that a feature, i.e., single mount, not disclosed in either Mankins et al., Pettus or Boland cannot come into being by their combination.

Therefore, Claim 28 is respectfully believed to overcome the rejection under 35 U.S.C. §103(a) as being unpatentable over Mankins et al. in view of Pettus and Boland.

**PATENT**

**CONCLUSION**

Therefore, it is now believed that all of the pending Claims in the present application are in condition for allowance. Favorable action and allowance of the Claims is therefore respectfully requested. If any issue regarding allowability of any of the pending Claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's Amendment, or if the Examiner should have any questions regarding the present Amendment, it is respectfully requested that the Examiner please telephone the Applicant's undersigned attorney in this regard.

Respectfully submitted,

By:

  
\_\_\_\_\_  
Kevin M. Kercher, Reg. No. 33,408  
**Thompson Coburn LLP**  
One US Bank Plaza  
St. Louis, MO 63101-1693  
(314) 552-6345  
(314) 552-7345 (fax)  
Attorney for Applicant  
**Dated: June 22, 2007**